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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/751,077	12/30/2003	Paul D. Stephens	RYL 2 0745-1	1258
27885	7590	09/21/2005	EXAMINER	
FAY, SHARPE, FAGAN, MINNICH & MCKEE, LLP 1100 SUPERIOR AVENUE, SEVENTH FLOOR CLEVELAND, OH 44114			TILL, TERRENCE R	
			ART UNIT	PAPER NUMBER
			1744	
DATE MAILED: 09/21/2005				

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

10/751,077

Applicant(s)

STEPHENS ET AL.

Examiner

Terrence R. Till

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is **FINAL**. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 8-10 and 12-77 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 8-10, 12-17 and 19-77 is/are rejected.
- 7) ☒ Claim(s) 18 is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☒ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
- ☐ Certified copies of the priority documents have been received.
 - ☐ Certified copies of the priority documents have been received in Application No. ____.
 - ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- ☒ Notice of References Cited (PTO-892)
- ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- ☒ Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date 12/30/03.
- ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____.
- ☐ Notice of Informal Patent Application (PTO-152)
- ☐ Other: ____.

DETAILED ACTION

Specification

1. The disclosure is objected to because of the following informalities: On page 5, line 11, applicants need to fill in the blank, identifying the correct serial number.

Appropriate correction is required.

Double Patenting

2. The nonstatutory double patenting rejection is based on a judicially created doctrine grounded in public policy (a policy reflected in the statute) so as to prevent the unjustified or improper timewise extension of the "right to exclude" granted by a patent and to prevent possible harassment by multiple assignees. See *In re Goodman*, 11 F.3d 1046, 29 USPQ2d 2010 (Fed. Cir. 1993); *In re Longi*, 759 F.2d 887, 225 USPQ 645 (Fed. Cir. 1985); *In re Van Ornum*, 686 F.2d 937, 214 USPQ 761 (CCPA 1982); *In re Vogel*, 422 F.2d 438, 164 USPQ 619 (CCPA 1970); and *In re Thorington*, 418 F.2d 528, 163 USPQ 644 (CCPA 1969).

A timely filed terminal disclaimer in compliance with 37 CFR 1.321(c) may be used to overcome an actual or provisional rejection based on a nonstatutory double patenting ground provided the conflicting application or patent is shown to be commonly owned with this application. See 37 CFR 1.130(b).

Effective January 1, 1994, a registered attorney or agent of record may sign a terminal disclaimer. A terminal disclaimer signed by the assignee must fully comply with 37 CFR 3.73(b).

3. Claims 8-10, 12-14 and 15-20 are provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9, 10 and 12-20 of copending Application No. 10/213,861 (allowed). Although the conflicting claims are not identical, they are not patentably distinct from each other because independent claim 12 is considered to be broader in scope than claim 8 of the present application as claim 12 of the '861 application essentially recites a housing, cyclonic airflow chamber having an inlet and outlet, a suction source mounted to the housing and a chamber inlet which includes a diverter that is associated with a removable lid. Thus, claim 12 fully encompasses claim 8 of the present application. Claims 9, 10 and 12-20 correspond to claims 9, 10 and 13-20 of the '861 application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

4. Claim 21 is provisionally rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claim 12 of copending Application No. 10/213,861. Although the conflicting claims are not identical, they are not patentably distinct from each other because claim 12 of the '861 application is considered to broadly recite the same subject matter of claim 21 of the application. Thus, claim 12 fully encompasses claim 8 of the present application.

This is a provisional obviousness-type double patenting rejection because the conflicting claims have not in fact been patented.

5. Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 9 and 13 of U.S. Patent No. 6,341,404. Although the conflicting claims are not identical, they are not patentably distinct from each other because the combination of claims 9 and 13 are considered to disclose, broadly, all the features presented in claim 8 and thus, fully encompass claim 8.

6.

7. Claim 8 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 7 and 14 of U.S. Patent No. 6,436,160 in view of Yonkers. The combination of claims 7 and 14 of the '160 patent disclose all the recited features with exception of an axial chamber outlet and an exhaust filter. The patent to Yonkers discloses a centrifugal vacuum cleaner having an axial outlet 88 and an exhaust filter 23 mounted within a housing. It would have been obvious to a person skilled in the art at the time the invention was

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made to provide an axial outlet and an exhaust filter to the combination of claims 7 and 14 in view of the teaching to Yonkers as an axial outlet is old and well known to cyclonic separators and an exhaust filter is necessary to remove any contaminants not separated, as demonstrated by Yonkers.

8. Claims 21, 63 and 77 is rejected under the judicially created doctrine of obviousness-type double patenting as being unpatentable over claims 16, 23 and 24 of U.S. Patent No. 6,436,160. Although the conflicting claims are not identical, they are not patentably distinct from each other because the combination of claims 16, 23 and 24 are considered to disclose, broadly, all the features presented in independent claims 21 and 63 and thus, fully encompass claim 21. The features of claim 77 are recited in the combination of claims 16, 23 and 24.

Claim Rejections - 35 USC § 102

9. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless –

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

(e) the invention was described in (1) an application for patent, published under section 122(b), by another filed in the United States before the invention by the applicant for patent or (2) a patent granted on an application for patent by another filed in the United States before the invention by the applicant for patent, except that an international application filed under the treaty defined in section 351(a) shall have the effects for purposes of this subsection of an application filed in the United States only if the international application designated the United States and was published under Article 21(2) of such treaty in the English language.

10. Claims 50, 59 and 60 are rejected under 35 U.S.C. 102(b) as being anticipated by Sparklin.

11. Sparklin discloses a vacuum cleaner comprising a base unit 16, including a nozzle opening 19 a housing 12,14 pivotally mounted on said base unit; a suction source 22,27 mounted

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to one of said base unit and said housing and communicating with said nozzle opening; a dirt receptacle 14 mounted to said housing, said dirt receptacle comprising a base wall 14b, a side wall (identified by 14) and an open upper end, said dirt receptacle comprising a filtration chamber 32 a filter 41 removably mounted in said filtration chamber; a lid 35 selectively covering said open upper end of said dirt receptacle; an inlet 39 to said filtration chamber, said inlet being located in said lid; and, an outlet 14d from said filtration chamber, said outlet being located on said dirt receptacle base wall. The filter 41 is considered to have a closed upper end (see figure 2) and a cap 42.

12. Claims 8-10, 12-17 and 19-77 are rejected under 35 U.S.C. 102(e) as being anticipated by Stephens et al. (6,436,160).

The applied reference has a common assignee with the instant application. Based upon the earlier effective U.S. filing date of the reference (1/11/01), it constitutes prior art under 35 U.S.C. 102(e). This rejection under 35 U.S.C. 102(e) might be overcome either by a showing under 37 CFR 1.132 that any invention disclosed but not claimed in the reference was derived from the inventor of this application and is thus not the invention "by another," or by an appropriate showing under 37 CFR 1.131.

13. Claims 21, 28, 50, 62, 63, 67, 76 and 77 are rejected under 35 U.S.C. 102(e) as being anticipated by Sepke et al.

14. Sepke et al. discloses all the recited subject matter of a vacuum cleaner comprising a base unit 101, including a nozzle opening 105, a housing 102 pivotally mounted on said base unit; a suction source (inherent in vacuum cleaners) mounted to one of said base unit and said housing and communicating with said nozzle opening; a dirt receptacle 106 mounted to said housing, said

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dirt receptacle comprising a base wall, a side wall and an open upper end, said dirt receptacle comprising a filtration chamber, a filter 124, mounted in a frame 150 for supporting said filter, removably mounted in said filtration chamber; a lid 116 selectively covering said open upper end of said dirt receptacle and having a tangential inlet to said filtration chamber that comprises a diverter wall 144; and, an outlet 187 from said filtration chamber, said outlet being located on said dirt receptacle base wall. The axial outlet from said filtration chamber communicates with an inlet of said suction source.

15. Claims 21, 28, 33 and 34 are rejected under 35 U.S.C. 102(e) as being anticipated by Yung.

16. Yung discloses a base unit 18; a housing 12 pivotally mounted on said base unit; a suction source 28 mounted to one of said base unit and said housing; a dirt receptacle 16 mounted to said housing, said dirt receptacle comprising a base wall, a side wall and an open upper end; a cylindrical filter 76 removably mounted in said dirt receptacle; and a lid 82 selectively covering said open upper end of said dirt receptacle, wherein said lid comprises a diverter wall 46 to channel an airstream flowing into said dirt receptacle into a cyclonic flow. The filter 124, mounted in a frame 34 for supporting said filter, removably mounted in said filtration chamber;

Claim Rejections - 35 USC § 103

17. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

18. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

19. This application currently names joint inventors. In considering patentability of the claims under 35 U.S.C. 103(a), the examiner presumes that the subject matter of the various claims was commonly owned at the time any inventions covered therein were made absent any evidence to the contrary. Applicant is advised of the obligation under 37 CFR 1.56 to point out the inventor and invention dates of each claim that was not commonly owned at the time a later invention was made in order for the examiner to consider the applicability of 35 U.S.C. 103(c) and potential 35 U.S.C. 102(e), (f) or (g) prior art under 35 U.S.C. 103(a).

20. Claims 8, 9, 10, 12, 14-16, 19 and 20 are rejected under 35 U.S.C. 103(a) as being unpatentable over Yung in view of Wright et al. (6,003,196).

21. The patent to Yung discloses all the recited subject matter as mentioned above, but does not disclose an exhaust filter housing with an exhaust filter. However, Yung does disclose of using an exhaust filter in the vacuum cleaner (see column 2, lines 15-23). There is no mention of how the filter is mounted, nor a PTFE-type filter. The patent to Wright '196 discloses a very similar upright vacuum cleaner and additionally discloses an exhaust filter housing "F" which contains a PTFE exhaust filter. It would have been obvious to a person skilled in the art at the

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time the invention was made to provide the device of Yung with an exhaust filter housing with a PTFE exhaust filter in view of the teaching of Wright et al. '196 as the exhaust filter of Yung would naturally need a housing and use of PTFE filter material was known at the time of the invention for its filtering ability.

22. Claim 27 is rejected under 35 U.S.C. 103(a) as being unpatentable over Yung in view of Rench et al.

23. The patent to Yung discloses all the recited subject matter as mentioned above, but does not disclose a pleated filter located in the dirt receptacle. However, The patent to Rench et al. discloses a cyclonic vacuum cleaner with a pleated filter 23 It would have been obvious to a person skilled in the art at the time the invention was made to provide the device of Yung with a pleated filter in view of the teaching of Rench et al. in order to increase the surface area of the filter and extend the life of the filter.

24. Claims 61 and 75 are rejected under 35 U.S.C. 103(a) as being unpatentable over Sepke et al. in view of Rench et al.

25. The patent to Sepke et al. discloses all the recited subject matter as mentioned above, but does not disclose a pleated filter located in the dirt receptacle. However, The patent to Rench et al. discloses a cyclonic vacuum cleaner with a pleated filter 23 It would have been obvious to a person skilled in the art at the time the invention was made to provide the device of Sepke et al. with a pleated filter in view of the teaching of Rench et al. in order to increase the surface area of the filter and extend the life of the filter.

Allowable Subject Matter

26. Claim 18 is objected to as being dependent upon a rejected base claim, but would be allowable if rewritten in independent form including all of the limitations of the base claim and any intervening claims.

Conclusion

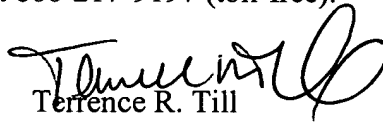
27. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The patents to Hug, Dyson, Ettridge, Brown et al., McCormick, Bowerman et al. and Oh et al. all disclose of upright vacuum cleaners having a dirt receptacle and a removable lid covering it.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Terrence R. Till whose telephone number is (571) 272-1280. The examiner can normally be reached on Mon. through Thurs. and every other Friday.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Sun U. Kim can be reached on (571) 272-1142. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).


Terrence R. Till
Primary Examiner
Art Unit 1744

trt